

Remarks

This Amendment is in response to the Office Action mailed August 10, 2006. Claims 1-17 were originally filed with the application. Claims 3, 11-17, were previously withdrawn, as a response to a Restriction Requirement. Claims 1-2, and 7-10 are pending and are currently rejected. Claims 1-2, 7-9, have been amended in this response and are believed to address each of the grounds of rejection. Applicant asserts no new matter has been added by any of the amendments. Reconsideration and allowance are respectfully requested in view of the foregoing amendments and following representations.

Claim 2 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action bases this rejection on the preamble of claim 2 reciting "consisting essentially of" followed by claims 7-9 depending from claim 2.

Applicant has amended herein claims 7, 8, and 9 so that they depend on Claim 1. Applicant believes this dependency addresses the rejection of Claim 2. Applicant respectfully request consideration and withdrawal of this rejection.

Claims 1 and 2 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which the Applicant regards as the invention. The Office Action has objected to the

recitation of "an effective amount" in the claim. Applicant hereby traverses this rejection because each clause reciting "an effective" amount gives a percent weight that applicant considers to be "an effective amount." Applicant believes that the currently claimed subject matter has been distinctly claimed and the claims are within the requirements of 35 U.S.C. §112. Applicant respectfully request reconsideration and withdrawal of the rejection.

Claims 1-2, and 7-10 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Edmundson et al., U.S. Patent No. 4,873,078, and Deckers et al., U.S. Patent No. 6,372,234. Applicant respectfully traverses this rejection. Claim 1 of the present invention calls for, *inter alia*, an improved liquid lip gloss composition:

- one lower alkyl ester of a fatty acid having 12 to 18 carbon atoms, wherein said alkyl ester is a liquid at 25°C;
- an effective amount of at least one odorant from 0.0002% through 2%; and
- an effective amount of at least one flavorant from 0.0002% through 2%.

The claimed subject invention is a liquid with an odorant, flavorant, and liquid lower alkyl ester.

Applicant respectfully addresses the Edmundson reference, which is a lipstick (*emphasis added*) composition. The Edmundson specification in column 1, line 13, defines lipstick as "a molded solid (*emphasis added*) fatty base containing dissolved and suspended dyes, preservatives, fragrance, in admixture with cosmetically acceptable waxes, oils, solids, and semi-solids." Edmundson is deficient because:

- (1) it teaches a solid and the subject application is relating to a liquid;
- (2) Edmundson does not have any teaching or suggestion for a lower alkyl ester that is a liquid at 25°C;
- (3) Edmundson does not have any teaching or suggestion for the flavorant present in the claimed range;
- (4) Edmundson does not teach use of an odorant.

The Office Action admits, on page 4, that the recited cosmetic oils, some of which at least are lower alkyl fatty acid esters, are solids at 25°C. The claimed invention of the subject application requires the lower alkyl ester of a fatty acid being a liquid (*emphasis added*) at 25°C.

Each of the examples provided by Edmundson in example 1, in column 4, require 4% of a flavor. It is well known to one skilled in the art that a much larger amount of flavorants, colorants, and odorants, are required when preparing solid compositions because components in a liquid are more easily interdispersed.

The liquid composition of the claimed subject invention provides for a flavorant in the range of 0.0002% through 2%. Thus the subject invention would require between 50-5000% less flavorant than the compositions taught by Edmundson.

One of ordinary skill in the art would not look to solid compositions where a liquid is desired. This is because, as taught and supported by Edmundson, solid compositions are heated while being processed (see Edmundson col. 4 lines 39-41). The heating is problematic with processing of flavorants and odorants because flavorants and odorants are typically organic oils with high volatility and low boiling points, as evidenced by the teaching of Edmundson requiring 50-5000 times more flavorant than the compositions of the subject invention. The present invention addresses the problems of heating organic oils while processing by providing for a liquid that does not require heat while processing.

The Office Action goes on to admit (page 4) that Edmundson does not teach the inclusion of an odorant in their lipstick composition.

In order to use a reference as prior art, the MPEP 2141.02 and applicable case law provide "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

Edmundson, as a whole, teaches a composition that is heated, melted, cooled and solidified. Edmundson does not teach the claimed liquid lip gloss having:

- one lower alkyl ester of a fatty acid having 12 to 18 carbon atoms, wherein said alkyl ester is a liquid at 25°C;
- an effective amount of at least one odorant from 0.0002 through 2%; and
- an effective amount of at least one flavorant from 0.0002 through 2%.

Because Edmundson does not teach or suggest the elements in the claimed invention, Applicant asserts Edmundson cannot support an obviousness rejection under 35 USC 103(a).

The Office Action relies on the teaching of Deckers in combination with Edmundson to purport supporting a case of *prima facie* obviousness. However, in combination, the (2) two references are still deficient.

The composition of Deckers taken as a whole is an emulsion to be incorporated in the formulation of the other compositions. While Deckers teaches fragrances for their emulsion, there is no recitation to include flavorants. It is well known in the art that many fragrances (i.e., perfume) do not have pleasant taste.

Applicant asserts, because the primary reference of Edmundson teaches a solid, and the teaching of Edmundson is deficient in that it does not teach a lower alkyl ester of a fatty acid being a liquid at 25°C, nor does Edmundson teach any effective amount of an odorant, nor does Edmundson teach an effective amount of a flavorant in the range claimed for the subject liquid composition, combination with Deckers does not cure these deficiencies. Even if, *en arguendo*, the teachings of

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Serial No.: 10/718,213
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Page 11

Edmundson and Deckers are combined, one of ordinary skill in the art would at best arrive at a solid lipstick composition that incorporates the emulsion of Deckers during processing.

Applicant asserts the combined references do not provide the requisite teaching or suggestion to the render the subject invention obvious. Applicant respectfully requests reconsideration of the rejection under 35 U.S.C. §103(a) and withdrawal of this rejection.

The Commissioner is hereby authorized to charge our Deposit Account No. 190734, should additional fee(s) be required, or credit any overpayment, in the filing of this document to expedite the prosecution of this application.

Respectfully submitted,

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